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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/028,888 | 12/19/2001 | Jeffrey G. Nowlin | 020375-006500US | 2318 |

20350 7590 02/26/2003

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EXAMINER

WOO, RICHARD SUKYOON

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,888

Applicant(s)

NOWLIN

Examiner

Richard Woo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "130" and "127" in Fig. 1A. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4) Claims 1-8, 10, 12, 15-21 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Long (EP 0,621,563).

Long discloses a method for producing and weighing a mailing unit, comprising:
determining a weight of each of the components and electronically storing its record (Fig. 2; databases 88, 90);

placing the inserts into the envelope (see Figs.);

determining the weight of the mailing unit based on the weights of the components that are stored in the weight record (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5);

predetermining the components, and summing the weights of the components of the mailing unit using a processor prior to assembly of the mailing unit (see Figs.);

reading an identifier on one of the inserts (34 in Fig. 2);

wherein the inserts are held in groups (see Fig. 1b);

selecting inserts from their respective groups and placing them onto the track (see Fig. 1b); and

wherein one of the inserts comprises a charge card that is attached to a card carrier, and one of a group including: letters, advertisements, checks, PIN mailers, phone cards and maps.

Long also discloses a system for producing and weighing mailing units, comprising:

a controller having a processor and a memory (see Fig. 2);

a movable track (see Figs.);

a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);

a moving mechanism to move the inserts from the track and into an envelope;

wherein the controller determines the weight of the mailing unit based on the weights of the components (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5);

an external storage device (see Fig. for 88, 90);

wherein one of the inserts has an identifier (see Fig. 2);

a reader (34) to read the identifier;

wherein the controller sums the weights of the components prior to assembly of the mailing unit;

wherein the controller sums the weights of the inserts as the inserts are placed onto the track; and

wherein the inserts are selected from a group including statements, card carriers, cards and advertising information.

5) Claims 1-2, 4, 7, 9, 12-14 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Delfer, III (US 5,264,665).

Delfer discloses a method for producing and weighing a mailing unit, comprising:

determining a weight of each of the components and electronically storing its record (see Fig. 1A);

placing the inserts into the envelope (col. 5, lines 60-68);

determining the weight of the mailing unit based on the weights of the components that are stored in the weight record (col. 4, lines 44-59);

predetermining the components, and summing the weights of the components of the mailing unit using a processor prior to assembly of the mailing unit (Id.);

wherein the inserts are held in groups (col. 4, lines 10-16);

wherein one of the inserts comprises a financial statement, and one of a group including: letters, advertisements, checks, PIN mailers, phone cards and maps;

organizing the mailing units based on a postage weight classification (see Figs. 1C, 2);

marking and mailing units that are different in weights than their classification (Id.).

Delfer discloses a computer system for producing and weighing mailing units, comprising:

a processor (col. 5, lines 60-68);

a memory including the weight of each of the components (see Fig. 1A);

wherein the processor determines the weight of the mailing unit based on the weights of the components (col. 5, lines 60-68).

Claim Rejections - 35 USC § 103

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long in view of Delfer, III.

Long discloses the invention as cited above but does not specifically disclose the invention including the insert being financial statement, and classifying the mailing units based on their weight within a given group via a marking.

Delfer teaches, for a system for determining the weights of the mailing units, that the system includes:

the insert being a financial statement; and

the device to classify the mailing units based on their weight within a given group (col. 6, lines 41-59).

Since Delfer and Long are both from the same field of endeavor, the purpose disclosed by Delfer would have been well recognized in the pertinent field of Long.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to include the financial statement as the insert and classify the mailing units based on their weight within a given group by using Long's existing printing means to mark those mailing units, as taught by Delfer, for the purpose of providing a computer directed system which accumulates and presents relevant data concerning mailing pieces sent and postage due.

Conclusion

8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baggarly et al. is cited to show an insertion machine having a data processor using the predetermined values indicative of the per item weight of items held in the stations to obtain a calculated total weight for each group of items.

Hill et al. is cited to show a card package machine including interchangeable inserters and carrier folders to enable use of forms of different types verifies the carriers if they are properly produced and rejects then if they are not prior to the attachment to a carrier.

"HCL Infosystems to market Pitney Bowes electronic inserting" is cited to show an inserting machine that is used to fold and insert papers into envelopes for mailing application with any human involvements. The machine can execute a variety of mailing jobs such as addressing, folding, inserting, weighing, rating and metering.

"Pitney Bowes exhibits low and mid range products at IDMF" is cited to show inserting machines that can memorize a plurality of applications and switch among them instantly. They also features document counting and optional reading facility enabling invoices, statements, mailshots and so forth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-

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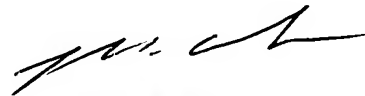
7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
February 24, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600